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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,692

04/16/2004

Peter Hotez

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08/02/2006

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EXAMINER

ZEMAN, ROBERT A

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,692

Applicant(s)

HOTEZ ET AL.

Examiner

Robert A. Zeman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-36 and 98-137 is/are pending in the application.
- 4a) Of the above claim(s) 34-36, 98-102, 110-134, 136 and 137 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 103-109 and 135 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1-11-2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group IV in the reply filed on 1-30-2006 is acknowledged. Claims 34-36 and 98-137 are pending. Claims 34-36, 98-102, 110-134 and 136-137 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Claims 103-109 and 135 are currently under examination.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The Information Disclosure Statement filed on 1-11-2005 has been considered.

An initialed copy is attached hereto.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 103-109 and 135 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The rejected claims are drawn to immunological compositions (vaccines) capable of stimulating an immune response in an animal *to* hookworm comprising a recombinant or synthetic antigen derived from hookworm. In other words, the immune response generated is to a given species of hookworm, not just the polypeptide.

The claims are drawn to a vast genus of immunogenic compositions comprising recombinant or synthetic antigen derived from hookworm that induce a directed immune response to a given species of hookworm. To fulfill the written description requirements set forth under 35 USC § 112, first paragraph, the specification must describe at least a substantial number of the members of the claimed genus, or alternatively describe a representative member of the claimed genus, which shares a particularly defining feature common to at least a substantial number of the members of the claimed genus, which would enable the skilled artisan to immediately recognize and distinguish its members from others, so as to reasonably convey to the skilled artisan that Applicant has possession of the claimed invention. To adequately describe the genus of *immunogenic* compositions comprising recombinant or synthetic antigen derived from hookworm, Applicant must adequately describe the antigenic determinants (immunoepitopes) that elicit an immune response directed against hookworm not just those determinants that would elicit an immune response to the polypeptide. A given polypeptide can be immunogenic but not induce an immune response directed against hookworm.

However, the specification does not disclose distinguishing and identifying features of a representative number of members of the genus of immunogenic compositions to which the claims are drawn, such as a correlation between the structure of the immunoepitope its recited function (to elicit an immune response directed against

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enteroaggregative *E. coli*), so that the skilled artisan could immediately envision, or recognize at least a substantial number of members of the claimed genus of immunogenic compositions. Moreover, the specification fails to disclose which amino acid residues are essential to the function of the immunoepitope or which amino acids might be replaced so that the resultant immunoepitope retains the activity of its parent, or by which other amino acids the essential amino acids might be replaced so that the resultant immunoepitope retains the activity of its parent. Therefore, since the specification fails to adequately describe at least a substantial number of members of the genus of immunoepitopes to which the claims are based; the specification fails to adequately describe at least a substantial number of members of the claimed genus of immunogenic compositions capable of stimulating an immune response in an animal *to* hookworm comprising recombinant or synthetic antigen derived from hookworm.

MPEP § 2163.02 states, “[a]n objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed'”. The courts have decided:

The purpose of the “written description” requirement is broader than to merely explain how to “make and use”; the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the “written description” inquiry, *whatever is now claimed*.

See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117

(Federal Circuit, 1991). Furthermore, the written description provision of 35 USC § 112 is severable from its enablement provision; and adequate written description requires

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more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

The Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, paragraph 1, "Written Description" Requirement (66 FR 1099-1111, January 5, 2001) state, "[p]ossession may be shown in a variety of ways including description of an actual reduction to practice, or by showing the invention was 'ready for patenting' such as by disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention" (*Id.* at 1104). Moreover, because the claims encompass a genus of variant species, an adequate written description of the claimed invention must include sufficient description of at least a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics sufficient to show that Applicant was in possession of the claimed genus. However, factual evidence of an actual reduction to practice has not been disclosed by Applicant in the specification; nor has Applicant shown the invention was "ready for patenting" by disclosure of drawings or structural chemical formulas that show that the invention was complete; nor has Applicant described distinguishing identifying characteristics sufficient to show that Applicant were in possession of the claimed invention at the time the application was filed.

The *Guidelines* further state, "[f]or inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species *cannot* be achieved by disclosing only one species within the genus" (*Id.* at 1106); accordingly, it follows that

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an adequate written description of a genus cannot be achieved in the absence of a disclosure of at least one species within the genus. As evidenced by Greenspan et al. (*Nature Biotechnology* 7: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan et al. recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an “epitope” (page 937, column 2). According to Greenspan et al., an epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows that the immunoepitopes that can elicit a directed and/or protective immune response to a given pathogen can only be identified empirically. Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of immunoepitopes, the skilled artisan could not immediately recognize or distinguish members of the claimed genus of immunogenic compositions capable of stimulating an immune response in an animal *to* hookworm (as opposed to the polypeptide encoded by the immunogenic composition) comprising a recombinant or synthetic antigen derived from hookworm. Therefore, because the art is unpredictable, in accordance with the *Guidelines*, the description of immunoepitopes (antigenic determinants) is not deemed representative of the genus of immunogenic compositions to which the claims refer.

Claims 103-109 are rejected under 35 U.S.C. 112, first paragraph, because the

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specification, while being enabling for immunogenic compositions capable of stimulating an immune response in an animal *to* the antigen itself, does not reasonably provide enablement for immunogenic compositions capable of stimulating an immune response in an animal *to* hookworm. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

The rejected claims are drawn to immunogenic compositions capable of stimulating an immune response in an animal *to* hookworm comprising at least one recombinant or synthetic antigen derived from hookworm. However, Applicant has failed to demonstrate polypeptides derived from hookworm that are capable of eliciting the claimed immune response (an immune response directed against the hookworm itself not just the polypeptide). While the skill in the art of immunology is high, to date, prediction of a specific immune response for any given composition in any given animal is quite unpredictable. Moreover, protein chemistry is probably one of the most unpredictable areas of biotechnology. Consequently, the effects of sequence dissimilarities upon protein structure and function cannot be predicted. Bowie et al (Science, 1990, 247:1306-1310) teach that an amino acid sequence encodes a message that determines the shape and function of a protein and that it is the ability of these proteins to fold into unique three-dimensional structures that allows them to function, carry out the instructions of the genome **and form immunoepitopes**. Bowie et al. further teach that the problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. (column 1, page 1306). Bowie et al further teach that while it is known that many amino acid substitutions are possible in any given protein, the position within the protein's

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sequence where such amino acid substitutions can be made with a reasonable expectation of maintaining function are limited. Certain positions in the sequence are critical to the three dimensional structure/function relationship and these regions can tolerate only conservative substitutions or no substitutions (column 2, page 1306). Additionally, as evidenced by Greenspan et al. (*Nature Biotechnology* 7: 936-937, 1999), defining epitopes is not as easy as it seems. Greenspan et al. recommends defining an epitope by the structural characterization of the molecular interface between the antigen and the antibody is necessary to define an "epitope" (page 937, column 2). According to Greenspan et al., an epitope will include residues that make contacts with a ligand, here the antibody, but are energetically neutral, or even destabilizing to binding. Furthermore, an epitope will not include any residue not contacted by the antibody, even though substitution of such a residue might profoundly affect binding. Accordingly, it follows that the immunoepitopes that can elicit a protective immune response to a given pathogen can only be identified empirically. This constitutes undue experimentation. Therefore, given the lack of success in the art, the lack of working examples commensurate in scope to the claimed invention and the unpredictability of the generation of protective immunity, the specification, as filed, does not provide enablement for immunogenic compositions capable of stimulating an immune response in an animal *to* hookworm comprising at least one recombinant or synthetic antigen derived from hookworm. Moreover, it should be noted that the rejected claims read on vaccines but the specification is silent as to what polypeptides would elicit a protective immune response against hookworm. Even if one would expect a given polypeptide to elicit an immune response to hookworm, there is no way to predict whether said response would be protective. One would be equally unable

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to predict whether polypeptides comprising “at least 80% homology” with a given antigen would elicit a protective response. Hence, with regard to the use of vaccines, the specification is not enabling.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 103-104, 107-108 and 135 are rejected under 35 U.S.C. 102(a) as being anticipated by Pritchard (WO 01/62802 – IDS filed on 1-11-2005).

Pritchard discloses the use of APR-1 and APR-2 (disclosed as SEQ ID NO:2 and 6 respectively) in vaccine compositions for the treatment of hookworm infections (see abstract, page 3 and sequence listing). Consequently, Pritchard anticipates all the limitations of the rejected claims.

Claims 103-104, 106 and 108 are rejected under 35 U.S.C. 102(b) as being anticipated by Bin et al. (Molecular and Biochemical Parasitology, 1999, Vol. 98, pages 143-149).

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Bin et al. disclose the use of ASP-1 in vaccine compositions for the treatment of hookworm infections in mice (see page 3143-144). Consequently, Pritchard anticipates all the limitations of the rejected claims.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (571) 272-0866. The examiner can normally be reached on Monday- Thursday, 7am -5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

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Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Robert A. Zeman". The signature is fluid and cursive, with a long horizontal stroke at the end.

ROBERT A. ZEMAN
PRIMARY EXAMINER

July 17, 2006